

## **REMARKS**

Applicant refers the Examiner especially to Figs. 9a-9g and 21. See specification page 32 and 45.

Claim 1 has no forward motive force but for the motor, which powers the tail boom downward. This simplified embodiment is shown in Fig. 21. Applicant has used the term “flipping” as synonymous with “panning” which is illustrated in a climbing mode in Figs. 9a-9g. Clearly if the stairs were removed from Figs. 9a-9g, the robot would move forward by flipping end to end with the tail remaining on the ground. The tail must rotate 360° again and again relative to the left and right body sections as claimed to accomplish this flipping. See attached hand drawn Figs. 9a-9g with the added “T” note to remind the Examiner what is going on.

Applicant’s invention as claimed in original claim 1 is neither anticipated or rendered obvious by either DeFazio or King. Applicant’s robot has no top or bottom and has the design of the continuously rotatable tail relative to the left and right body sections. Both of these unique features are missing from Examiner’s references. Note that King merely rotates a rear drive assembly (28, 30, 32, 34) around a rear jackshaft (92), which is mounted, in his robot body (chassis 10), which has a defined top and defined bottom. At col. 4, line 35 et seq., King describes an accidental “flipping on its back” of his robot body, which disables the robot. Col. 2, line 67 defines King’s turret 36 clearly mounted on the top of the chassis 10.

This is a clear teaching away from Applicant’s claimed invention, which has neither a top nor a bottom and continuously flips over. King offers no basis for an obviousness rejection.

Applicant’s original claim 20 is narrower than claim 1 by including the powered wheels. The limitation of “flip (pan)” also distinguishes this claim from Examiner’s references.

## **LAW OF OBVIOUSNESS**

It is well known that most inventions are composed of elements that *per se* are old and well known. That however, does not make an invention “obvious” under 35 U.S.C. 103. The Examiner’s attention is respectfully drawn to, for example, *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984), wherein the Court held that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed combination, absent some teaching or suggestion supporting the

combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.”

Also, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 USPQ 303 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if all the constituents of an invention may be old, if the result would not have been obvious at the time the invention was made to a person having ordinary skill in the art, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F.2d 501, 503-504, 128 USPQ 25, (2d Cir. 1960).

In order to determine the basis for the rejection, the Examiner must:

- 1). Determine the scope and contents of the prior art;
- 2). Ascertain the differences between the prior art and the claims in issue;
- 3). Resolve the level of ordinary skill in the pertinent art; and
- 4). Evaluate evidence of secondary considerations.

Other basic considerations include:

- 1). The claimed invention must be considered as a whole;
- 2). The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- 3). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4). Reasonable expectation of success is the standard with which obviousness is determined.

Finally, to sustain a *prima facie* case of obviousness:

- 1). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

- 2). There must be a reasonable expectation of success; and
- 3). The prior art reference must teach or suggest all the claim limitations.

The Examiner fails to meet the requirements to sustain an obviousness rejection based on these references.

Applicant respectfully requests the Examiner to pass this application to allowance.

Respectfully submitted,

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